

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

SUNEARTH, INC.; and THE SOLARAY
CORPORATION,

Plaintiffs,

v.

SUN EARTH SOLAR POWER CO., LTD.;
NBSOLAR USA, INC.; and DOES 1-10,

Defendants.

No. C 11-4991 CW

MODIFIED
PRELIMINARY
INJUNCTION

_____/

For the reasons set forth in its concurrently-filed Order Granting in Part Defendants' Motion to Amend the Preliminary Injunction, the Court vacates its preliminary injunction issued on February 2, 2012 and issues a modified preliminary injunction as follows:

IT IS HEREBY ORDERED, ADJUDGED AND DECREED that Defendants and their officers, agents, servants, affiliates, employees, and attorneys, and all those acting in concert or participation with any of them who receive actual notice of this Order, are HEREBY ENJOINED:

1. From using or continuing to use the words "SUN EARTH" (with or without a space or capitalization or hyphen), either alone or in conjunction with any other words or symbols, or any phonetically or visually similar words or symbols in any combination, as a trademark, service mark or trade name within the United States, its territories or possessions (the "Territory"), provided that:

1 A. for goods branded as NBSolar rather than Sun Earth,
2 Defendants shall be permitted to identify SESP as the
3 manufacturer, importer or seller of the goods to the minimum
4 extent necessary as required by law or ordinary business customs
5 to operate within the United States under the NBSolar name; and

6 B. for equipment purchased by Defendants from sellers
7 within the United States for export to SESP in China, Defendants
8 shall be permitted to identify SESP as the buyer of the equipment,
9 to the minimum extent necessary as required by law or ordinary
10 business customs.

11 C. Under subsections A and B above, wherever possible,
12 Defendants shall identify themselves as NBSolar and/or an acronym,
13 such as SESP, that avoids the use of the words "SUN EARTH" (with
14 or without a space or capitalization or hyphen). Where Defendants
15 do use the words "SUN EARTH" under the terms of these subsections,
16 Defendants shall not display the words "SUN EARTH" in a
17 distinctive manner of presentation that makes them stand out in
18 any way from other words on the relevant document and shall not
19 use the "Sun Earth" logo.

20 2. From using or continuing to use the words "SUN EARTH" (with
21 or without a space or capitalization or hyphen), either alone or
22 in conjunction with any other words or symbols, or any
23 phonetically or visually similar words or symbols in any
24 combination, in, or in connection with, any marketing or
25 advertising or any other promotional materials viewable within the
26 Territory;

27 3. From using or continuing to use the words "SUN EARTH" (with
28 or without a space or capitalization or hyphen), either alone or

1 in conjunction with any other words, as an keyword or other
2 triggering mechanism to generate any internet advertising viewable
3 within the Territory; and

4 4. From importing into the Territory any goods upon which the
5 words "SUN EARTH" (with or without a space or capitalization or
6 hyphen), either alone or in conjunction with any other words or
7 symbols, or any phonetically or visually similar words or symbols
8 in any combination, appears or are shown on the packaging for such
9 goods.

10 5. Upon either Plaintiff's request, the top level domain (TLD)
11 Registry for SunEarth.us (Neustar, Inc.) shall, within thirty (30)
12 days of receipt of this Order, place that domain name on Registry
13 Hold status, thus removing it from the TLD zone files maintained
14 by the Registry which link the domain name to the internet
15 protocol address where the associated website is hosted.

16 6. Nothing in this Order shall preclude Defendants from
17 registering any country code top level domain [such as .cn (for
18 China) or .de (for Germany)], except for the .us country code top
19 level domain, which contains the words "SUN EARTH" (with or
20 without a space or capitalization or hyphen), either alone or in
21 conjunction with any other words, or from publishing one or more
22 websites at any of those country code top level domains.

23 7. Defendants shall, within thirty days of the date of this
24 Order:

25 A. Take reasonable measures to ensure that visitors from
26 within the United States who visit Sun-Earth.com,
27 SunEarthPower.com, and SunEarthPower.net are presented with a
28 webpage that: (1) allows them to choose to continue to either the

1 nbsolar.com home webpage or the sunearthinc.com home webpage; and
2 (2) contains language clarifying that the companies associated
3 with those webpages are not affiliated with one another;

4 B. Replace the Sun-Earth logo which currently appears at
5 the top of each webpage on the nbsolar.com domain with the nbsolar
6 mark and logo;

7 C. Add to the nbsolar.com home webpage the following
8 explanation, or a similar variation thereof: "NBSolar USA, Inc.
9 has no affiliation with SunEarth Inc. or The Solaray Corporation.
10 NBSolar USA, Inc., is a distributor within the United States of
11 products carrying the NBSolar brand, manufactured by Sun Earth
12 Solar Power Co., Ltd., of Ningbo, China. Outside of the United
13 States, Sun Earth Solar Power Co., Ltd. sells products under the
14 brand Sun-Earth. All sales in the United States, however, use
15 only the NBSolar brand."; and

16 D. Remove all uses of "Sun Earth" from the keyword metatags
17 of the nbsolar.com domain.

18 8. Nothing in this Order shall preclude Defendants from
19 explaining within the United States, including at trade shows and
20 conferences, their affiliation with their Sun-Earth name and mark
21 as used outside of the United States in the following manners:

22 A. By explaining orally their affiliation with the Sun
23 Earth name and mark that they use outside of the United States; or

24 B. By displaying at trade shows and conferences where the
25 NBSolar logo is displayed, one stand-alone sign on their trade
26 show booth, the sign being no larger than 12 inches x 12 inches in
27 black and white font not larger than 20 point typeface, the
28 following explanation, or a similar variation thereof: "NBSolar

1 USA, Inc. has no affiliation with SunEarth Inc. or The Solaray
2 Corporation. NBSolar USA, Inc., is a distributor within the
3 United States of products carrying the NBSolar brand, manufactured
4 by Sun Earth Solar Power Co., Ltd., of Ningbo, China. Outside of
5 the United States, Sun Earth Solar Power Co., Ltd. sells products
6 under the brand Sun-Earth. All sales in the United States,
7 however, use only the NBSolar brand." Defendants shall not depict
8 the words "Sun Earth" in a different manner of presentation in any
9 way from the other words in that sentence and on that sign.

10 Defendants shall not display their Sun-Earth logo on that sign.

11 9. Because Plaintiffs have filed with the Court evidence of a
12 bond in the sum of \$5,000.00, see Docket No. 67, this preliminary
13 injunction shall take effect immediately upon issuance.

14 10. Defendants shall file with the Court and serve on Plaintiffs,
15 within thirty-five (35) days after the effective date of the
16 original Preliminary Injunction, a report in writing and under
17 oath, setting forth in detail the manner and form in which
18 Defendants have complied.

19 11. This preliminary injunction shall continue in effect until
20 final judgment in this case, unless ordered otherwise.

21 IT IS SO ORDERED.

22
23 Dated: 3/13/2012

24 
25 CLAUDIA WILKEN
26 United States District Judge
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